

Remarks

Claims 1 through 4 and 7 through 10 remain pending in the application. The office Action maintained the rejection of claims 1-4 and 7-10 as unpatentable over McCook, Recreational Printing Device, U.S. Patent 5,980,351 (Nov. 9, 1999) in combination with Conrad, Dough Cutter with Interchangeable Cutting Elements, U.S. Patent 4,327,489 (May 4, 1982) for reasons of record in Paragraph 5 of the office action mailed September 23, 2003. As explained further below, the Office Action has not offered a motivation to combine the references and no such motivation exists. Furthermore, the very fact that no one, except for Applicants, has shown or disclosed such a seemingly simple invention proves that the claims are non-obvious.

The examiner's rejection expressed in paragraph 8 is based on his personal experience. When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. 37 CFR 1.104(D)(2); MPEP §2144.03. Applicant hereby requests that the examiner prepare and sign an affidavit specifically pointing out the facts, details, dates and any other relevant facts pertaining to the examiner's personal knowledge of his children using cookie cutters in the sand for imprinting shapes, his seeing many other parents using such devices, and that the invention has been practiced by many children at the beach. In his affidavit, we request in particular that details be specified as to the critical dimensions in those cookie cutters and how they compare to the Bitton invention, so that the applicant can contradict these assertions.

The applicant is submitting evidence that her invention is a vast improvement over the McCook device. Specifically, Exhibit 1

is a photograph of an imprint left in sand using a McCook type device. Exhibits 2 through 6 are photographs of imprints left in sand using the Bitton invention. As is plain to see from the photographs, the McCook device leaves no detail when imprinted in the sand and virtually no imprint whatsoever in the sand. The McCook device requires that a great deal of force be exerted on the stamp for any impression to appear in the sand. This fact was presented in the applicant's specification (page 2 line 1 through 7) filed three years ago and is further evidenced by Exhibit 1. The distinctions in the type of blades used in applicant's invention imprint clear designs in the sand. The critical dimensions of applicant's device are such that when imprinted in the sand or snow, the imprint will be clean and clearly recognizable.

Exhibit 1 demonstrates a McCook type device in the shape of a dolphin with broad, flat, indicia. The stamp is shown on the right hand side of the photograph, and the sand imprint the stamp leaves is shown on the left hand side. Note that the imprinted sand does not identify any details. Specifically, the outline of the stamp is the only detectable feature, and even the silhouette outline is barely visible at all in the imprinted stamp.

Exhibits 2 through 6 show imprints made from various sand dies according to the Applicant's invention. Exhibit 2 demonstrates the various different letters spelling out the words "sand stamps." This exhibit demonstrates how applicant's silhouette blades generate clear, distinct imprints in the sand. The specific blade dimensions allow the letter to be clearly readable, even when imprinted within the sand. This type of clarity cannot be achieved by the stamps of the McCook device. In Exhibit 3, the eyes, eyelashes, whiskers, nose, and mouth of the bunny are clearly imprinted on the sand. The detail is so great that the small smiling mouth and bright eyes are clearly identifiable within the sand. This amount of detail is cannot be

attained with the McCook stamp. Exhibit 4 illustrates a Winnie the Pooh die. All of the detail from Winnie are imprinted in the sand, including the facial features, the body features, as well as the pot of honey held by the character. Exhibit 5 illustrates an elephant die. This die clearly demonstrates all of the body details of the elephant. The ears, eye, and legs of the elephant can be clearly viewed in the sand imprint. Exhibit 6 illustrates a lion where, once again, all the details are clearly discernable. The face and body details are clearly imparted onto the sand by the die.

Further, the Office Action still fails to state prima facie obviousness rejection because the Office Action still fails to state a motivation to combine the references as required by Graham v. John Deere, 383 U.S. 1 (1966). The Office Action statement that it would be obvious to combine the references because "the combination has been fairly taught and suggested by the prior art" is conclusory, self-serving, and yet still does not provide a motivation to combine the references.

Applicant argues that the only motivation comes from its own application. Absent a showing in the prior art, the Examiner has impermissibly used "hindsight" occasioned by the applicant's teaching to hunt through the prior art for the claimed elements and combine them as claimed. In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). Understandably the applicant's invention is easy to understand and therefore easily susceptible to attack, however, to reject the claims without providing the appropriate motivation from the prior art is an inappropriate process by which to determine the patentability.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner has

provided no teaching supporting the combination of the two cited references, either in the references themselves or other. The Examiner has provided no suggestion supporting the combination of the two cited references, either in the references themselves or other. The Examiner has provided no incentive supporting the combination of the two cited references, either in the references themselves or other. The Examiner must be able to point to something in the prior art that suggests in some way a modification of a particular reference or a combination with another reference in order to arrive at the claimed invention.

The motivation to combine is simply not found in the two references provided by the examiner. Conrad does not mention sand and McCook does not mention cookie dough. McCook discloses a stamp with a flat broad indicia for making imprints in soft ground or sand. McCook certainly provides no suggestion to strap the device onto the feet of the user and stomp on cookie dough in order to make cookies. Conrad describes a cookie cutter, but provides no suggestion to have the user take this seemingly expensive baking device to the beach to make imprints in the sand. I personally would hate to eat cookies made with a Conrad device after someone used it at the beach, nor would I allow my child to bring my expensive William Sonoma cookie cutters to the beach. Thus, no motivation exists in the references themselves to combine the references.

The examiner's statement that there is no exclusion that the die of McCook could not be used in cutting cookie dough is patently false. Were Conrad used on cookie dough, it would leave an imprint in the dough, with no cutting of the dough, and the imprint, when baked, would rise sufficiently so as to obliterate the imprint. Quite frankly, McCook barely works in sand, as shown in Exhibit 1, let alone cookie dough.

Furthermore, the statement would lead one of ordinary skill to the opposite conclusion: that the claims are not obvious. If

there were a publicly known motivation to combine the references, then at least one person among hundreds of millions of people in the United States would have invented the claimed products during one of billions of days playing on the beach, even playing on the beach with a McCook device, or one of billions of days in the kitchen making cookies and subsequently manufactured and sold the products covered by the claimed inventions. Someone would have been motivated to gain a piece of a multi-billion dollar market. However, only Applicants and the Examiner have proposed the claimed inventions. Thus, the claims must be non-obvious regardless of how simple the claimed inventions may appear.

Similarly, because only Applicants and the Examiner have proposed the claimed devices in the nearly 5 years since McCook issued, the Examiner must have used impermissible hindsight when fashioning the obviousness rejections. Hundreds of millions of people, some of them highly trained and motivated in this art, have failed to disclose or sell the claimed inventions. Thus, without some reference to which the Examiner can cite, one must conclude that the Examiner did not use a pre-existing motivation to combine the references, but rather relied on Applicants' own disclosure. Accordingly, Applicants request that the rejections be withdrawn and the claims allowed.

In addition, the sand toy market is a billion-dollar industry. Highly trained and intelligent individuals working in these industries have a powerful motivation to search the PTO database and find and combine the references, or otherwise create and sell the claimed inventions. In light of the unappreciated advantage of higher sand toy sales, one of these individuals would have combined the references or otherwise would have created and sold the claimed inventions had they been obvious. Thus, the claims are non-obvious.

Even if combined, the resulting combination does not meet all of the claims of the limitations. Applicant's claims require that

the blade have a thickness of about .125 inches and a minimum depth of about .03125 inches. Furthermore, Claims 1, 4, 7, and 10 require that the blades be separated from adjacent detail blades by a minimum distance of about .045 inch. These dimensions were chosen to make details imprints in the sand. These blade dimensions are not present in McCook as the "printing indicia" in McCook are defined to be flat broad indicia. The blocks with embedded flat indicia are stable enough so that a user can walk erect while wearing the blocks and make images in soft ground or sand. Applicant's blades are not likely to be contained on the McCook device because the blades would not provide the appropriate stability and support for the wearer to be able to walk upright.

With regard to Conrad, the patent does not claim blades of any particular thickness, height, or distance apart from each other. The distance defined within Applicant's claims is ideal for ensuring that enough grains of sand can appropriately fit in between the blades to leave a marking within the sand. Conrad only identifies that it is preferred that the impressing walls have a height less than the height of the ribs so that a cut is not made completely through the dough (column 2, line 58). Because Applicant's blades are not used to cut through a dough-like substance to form a three-dimensional object, the appropriate blade thickness, height, and distance apart are different than that required to leave an impression on dough-like material. The critical dimensions of Applicant's blades are specified such that the device when imprinted in sand or snow will form clean imprints in the desired medium. The critical dimensions are not needed or are different in Conrad because the device forms 3-dimensional objects, not imprinted designs. Further, the cookie dough rises and the details would be blurred by the baking process not inherent in Applicant's invention.

The prior art references do not contain any suggestion that they be combined in the manner suggested by the Examiner. The

Examining Attorney argues that the deficiency of providing detail blades to imprint more details or better imaging with a modicum of effort is found in Conrad who teaches imprinting with a die cutter with detail blades in a soft surface such as dough. The Conrad cookie cutter discloses blades that are spaced at certain distances apart to create more detail to a cookie. The greater amount of detail is attainable because the cutter imprints a desired shape onto an entirely different medium. For example, where a dough-like substance is used, the imprinted dough is picked up by a user and placed on a surface for baking. The cutter can accommodate for more detail because the surface into which the cutter is being positioned is capable of maintaining a greater amount of detail. The McCook indicia instead make a mark on a soft grainy surface. The surface on which the mark is made is not capable of being handled by a user. The mark is made merely for the enjoyment of the user while playing on the soft surface. There is no suggestion to combine features of a cookie cutter, intended for cutting detailed dough prior to baking of, with soft surface imprinting indicia. It is unsuggested to combine a cookie cutter with a footwear block toy.

The Applicant's invention possesses unappreciated advantages and results in unexpected results that up to now those skilled in the art have never appreciated. The use of a type of blade to make an impression in sand or snow is likely inherent. The use of a blade can leave a defined mark in a surface in which it is inserted. However, the use of a blade on a toy to leave marks has never to date been utilized. Applicant has tested various types of indicia and their effectiveness at leaving an imprint on the desired medium. It is inherent that the devices with blades left the most distinct markings. However, although blades are great for cutting into cookie dough, the use of them to cut into sand has not been appreciated until now. The Applicant's invention possesses unexpected results when it is utilized. The use of the blades for marking in the sand or snow has results in a clear,

detailed marking. To make the mark, a small amount of force need be exerted to the device. Even a young child can make clear, vivid marks with minimal effort. the use of the blade achieves superior results that have not been seen in any similar device to date.

The invention described in Conrad is not within the scope of the art for one skilled in the art of making designs in the sand. One skilled in the art of practicing a method of imprinting sand or snow with a sand die is likely between the ages of 2 and 10 years old. One skilled in the art of cooking is likely older than 10 years old because of the potential dangers associated with the use of kitchen appliances. Therefore, these do not require the same skill in the art.

The cited reference is from a different field. A cookie dough cutting device is not closely related to a soft surface imprint toy. A person interested in cooking that utilizes cooking devices is not likely to recognize a benefit of using a cookie cutter outside on a soft surface. Conversely, a child is not likely to think that his toy would be good for use in shaping cookies. Additionally, the medium that each device is used with is not similar. A toy die is likely to be used in the sand, snow, or other soft surface located outdoors. Sand is comprised of grains that do not adhere well to each other if attempted to be picked up. Cookie dough is instead cohesive and easily shaped, moved or transported by a user. Sand that is imprinted by any device could never be handled in a manner similarly to cookie dough. The fields are distinctive from each other such that a device used in one would not be easily utilized in the other.

The references themselves are individually complete. Both of the references cited by the Examining Attorney are complete and functional by themselves. Therefore, there would be no reason to use elements or parts from or substitute parts to either of the references.



Finally, the problem solved by the invention has never before been recognized, and the recognition of an unrecognized problem militates in favor of patentability. Applicant's experimentation with use of McCook like devices has demonstrated that flat broad indicia do not provide clear marks within sand. In order to obtain marks with the greatest amount of detail, it is necessary to use blades as in Applicant's device. If in fact the Conrad cookie cutter were used to make the footwear or handwear blocks of McCook, the fact that use of such indicia is not even mentioned or suggested militates in favor of patentability. Furthermore, if the invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. The Conrad cookie cutter patent has been around since 1982 while the device in McCook has been around since 1999. The fact that those skilled in the art in McCook have not implemented the invention, despite its great advantages, indicates that it is not obvious. The examiner admits in paragraph 8, that "perhaps applicant has a better die for imprinting sand than some of the dies on the market" (not that we are aware of any sand dies on the market).

#### Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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